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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/707,510

12/18/2003

Frederick W. Ryan JR.

F-775

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919 7590 02/21/2007

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EXAMINER

JABR, FADEY S

ART UNIT

PAPER NUMBER

3628

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

02/21/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	Application No. 10/707,510	Applicant(s) RYAN ET AL.	
	Examiner Fadey S. Jabr	Art Unit 3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 February 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>7/27/06</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per Claim 1, the recitation “and if the refund request is value, processing the refund request”, is vague and indefinite. It is unclear to the Office what occurs when the refund request is not valid. Appropriate correction is required in the indicated claim and any subsequent claims.

### *Claim Rejections - 35 USC § 101*

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 1 is rejected under 35 U.S.C. 101 because, the limitation, “determining if the refund request is valid; and if the refund request is valid, processing the refund request” as recited is an open-ended conditional statement. The use of open-ended conditional language would not render the entire claim useful, tangible or concrete. The language presented only makes allowances for when the refund is request has been found to be valid. There is no allowance made in the event that the request has been found not to be valid. Therefore, as the claim is currently presented, it could be possible that there would be no action by the program if

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a refund request was found to be invalid. In this case, there would be no concrete, tangible or useful outcome in the case. Thus, the claim is directed to non-statutory material.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-3 and 5 are rejected under 35 U.S.C. 102(e) as being anticipated by Gullo et al., Pub. No. US2004/0044586 A1.

As per **Claim 1**, Gullo et al. discloses a method for processing a postage refund request for a mail piece comprising:

- receiving a refund request including a tracking identifier from a user system (0015);
- determining if the refund request is valid; and if the refund request is valid, processing the refund request (0019-0020), wherein, the determination of whether the refund request is valid includes determining whether the tracking identifier has been observed in a mail stream (0019-0020).

As per **Claim 2**, Gullo et al. discloses if the refund request is not valid, initiating a refund error process (0018-0019).

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As per **Claim 3**, Gullo et al. discloses the refund error process includes a fraud inquiry (0019-0021).

As per **Claim 5**, Gullo et al. discloses determining if the mail piece is associated with the user that submitted the refund request (0018).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims **4, 6, 13 and 14** are rejected under 35 U.S.C. 103(a) as being unpatentable over Gullo et al., Pub. No. US2004/0044586.

As per **Claim 4**, Gullo et al. fails to *explicitly* disclose the refund error process includes notifying a postal authority. However, Gullo et al. discloses a system that may be carried out online or by directly going to a local post office. Therefore, when a user receives a refund error from the system (operated by the USPS) they are receiving the notification from the postal authority (Figure 1). Moreover, when a user has their account suspended for suspicion of fraud, they have to contact the local post office to reactivate their account (0021).

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As per **Claim 6**, Gullo et al. fails to *explicitly* disclose determining if a refund test period has completed; and if the refund test period is not completed, performing another determination of whether the mail piece has been observed in the mail stream. However, Gullo et al. discloses queuing the request for a designated period, for example, seven days, to check for scan events (0019-0020). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Gullo et al. and include queuing for scan events over a designated period of time, because it allows the system to check multiple scan events over a designated period of time to ensure that there is not an active scan event for the tracking/label number (0019).

As per **Claim 13**, Gullo et al. discloses the refund test period is one week (0020).

As per **Claim 14**, Gullo et al. discloses the refund test period is variable (0020).

8. Claim **15** is rejected under 35 U.S.C. 103(a) as being unpatentable over Gullo et al., Pub. No. US2004/0044586 A1 in view of Official Notice.

As per **Claim 15**, Gullo et al. fails to disclose the variable length of the refund test period depends upon the class of service of the mail piece. However, Examiner takes Official Notice that different mail service classes vary in the amount of time to deliver the mail item. For example, priority mail might take one day to deliver an item, while second class mail may take three to five business to deliver an item. Therefore, it would have been obvious to one of

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ordinary skill in the art at the time of applicant's invention to modify the method of Gullo et al. and queue the refund request for a designated time period associated with the mail item class, because it would allow the system to process scan events for a more suitable time period to maximize retrieving scan events of the mail item.

9. Claims 7-12 and 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gullo et al., Pub. No. US2004/0044586 A1 in view of Montgomery et al., Pub. No. US2003/0101148 A1.

As per Claims 7-10, Gullo et al. fails to disclose the tracking identifier includes a 22-digit delivery confirmation PIC code, a PLANET code and a POSTNET code, a postage serial number and a postage meter postage ascending register value, or a postal ID tag. However, Montgomery et al. teaches a method for detecting postage fraud using tracking identifiers. Further, Montgomery et al. discloses tracking identifiers being one or two-dimensional barcodes, PLANET or POSTNET codes (0060-0063, see Figures 19-22). Further, Montgomery et al. teaches associating the information based indicium along with the tracking identifier, where the IBI contains ascending register value, license zip, the certificate serial number, etc. (0080, 0096, also see Table 2). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Gullo et al. and provide a tracking identifier that includes various codes and pertinent information as taught by Montgomery et al., because it allows the system to associate a plurality of information associated with the mail piece when attempting to track the mail piece through the mail stream.

As per Claims 11-12 and 16-18, Gullo et al. discloses sending the refund request to the postal authority (see Figure 1). Gullo et al. fails to disclose processing the refund request includes aggregating a group of valid refund request associated with a postage broker, processing the refund request includes aggregating a group of valid refund requests and sending a group refund request associated with the aggregated group of valid refund request to a postal authority, sending aggregated refund request data to the postage broker. However, Montgomery et al. teaches a refund eligible inquiry that allows a user or administrator working on behalf of the mail user to poll eligible refund requests, where a user can select the eligible refund requests to send to the USPS (000170-0171, 0174-175, see Figures 26-28). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Gullo et al. and allow a user to choose from a plurality of postal transaction to select the transactions that require a refund in order to send to the postal authority as taught by Montgomery et al., because it allows a user to select the correct transaction or transactions from a plurality of transactions and more efficiently process the refund requests in order to minimize the refund return around time.

### *Conclusion*

Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that the applicant, in preparing the responses, fully consider the references



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in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

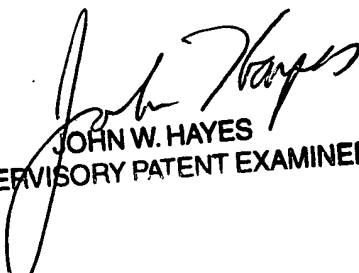
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fadey S. Jabr whose telephone number is (571) 272-1516. The examiner can normally be reached on Mon. - Fri. 7:30am to 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on (571) 272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Fadey S Jabr  
Examiner  
Art Unit 3628

FSJ

  
JOHN W. HAYES  
SUPERVISORY PATENT EXAMINER

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